

### **Remarks**

Claims 1-22 and 24-50 are pending in the present application. Claims 1-30 are rejected under 35 U.S.C. § 101. Claims 1-22 and 24-50 are rejected under 35 U.S.C. § 103.

Independent claims 1 and 17 are amended to further describe the processor as being operable to:

search an inventory database for a product matching the product configuration data, the inventory database containing products on the order bank, in-production, in-transit, and in inventory;  
store a computerized search reply message in a reply database

The antecedent basis for this amendment is found in the Specification on page 28, l. 33 to page 29, l. 3 and on page 29, ll. 27-28. Claim 1 is further amended to replace "the user" with "a user." No new matter is added by these amendments.

#### **A. Claim Rejections under 35 USC § 101**

Claims 1-30 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner states that "the steps are divorced from the processor since there is no tangible medium recited in the claim language which would allow the processor to retrieve the necessary data and store the results." Applicant has amended independent claims 1 and 17 in the manner set forth above. These amendments provide the requisite medium which are the inventory database and the reply database. Accordingly, claims 1-30 are now patentable under 35 U.S.C. § 101.

#### **B. Claim Rejections under 35 USC § 103**

Claims 1, 3, 4, 6-9, 11, 12, 15-18, 20-22, 25, 26, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (U.S. Patent No. 6,282,517 B1) in of Peterson et al. (U.S. Patent No. 6,324,522 B2).

Applicant respectfully asserts that the Examiner has failed to provide a prima facie case of obviousness regarding independent claims 1 and 17. The Examiner has combined Wolfe and Peterson in an attempt to synthesize the present invention. However, as acknowledged by the Examiner, the combination is still lacking an essential limitation contained in independent claims 1 and 17:

Wolfe and Peterson **do not teach that the second dealer is selected by the user.** However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to do so. One of ordinary skill in the art would have been motivated to do so in order to allow a user to select a dealer that was geographically close to the customer.

Office Action dated May 5, 2004, p. 4 (emphasis added).

The Examiner provides the missing limitation by fiat without providing any authority or prior art references supporting his assertion. The Examiner's insertion of allowing the user to select the second dealer sounds in an official notice type of rejection (although the Examiner hasn't described it as such.) Accordingly, the applicant traverses the Examiner's assertion and requests that appropriate prior art be provided as required under MPEP 2144.03.

Notwithstanding the argument set forth above, it is evident that the Examiner has inappropriately combined Wolfe and Peterson together using hindsight to fill in the missing limitations in the combination. The Examiner is using the applicants own disclosure to provide the missing limitations of the combination of Wolfe and Peterson. Moreover, the rejection of claims 1 and 17 is improper because the Examiner has not shown the required teaching, suggestion, or motivation in Wolfe or Paterson or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify Wolfe or Paterson. The rejected claims are allowable for at least this reason.

The standard for finding obviousness on a combination of references has been set forth in Applicant's February 6, 2004 response. In summary, the M.P.E.P. sets forth the strict legal standard for finding obviousness based on a combination of references:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention.

. . .

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680.

M.P.E.P. 2143.01.

The Examiner fails to provide an appropriate motivation or teaching for combining Wolfe and Peterson together. The Examiner uses Paterson to provide "a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory." The Examiner characterized the motivation for the combination:

One of ordinary skill in the art would have been motivated to do so in order to allow a vendor (dealer) to provide a customer with an item that the vendor did not have in its inventory by purchasing the item from another vendor.

Office Action dated May 5, 2004, p. 3-4.

Clearly, the Examiner has not pointed to any passage of Wolfe or Peterson that explicitly or implicitly suggests a combining of the references. Instead, the Examiner uses the teachings and advantages of the present invention in hindsight to provide the motivation. Accordingly, independent claims 1 and 17 are each allowable over the combination of Wolfe and Peterson.

Independent claims 1 and 17 are also allowable over the combination of Wolfe and Peterson because Peterson does not provide the missing limitation of "a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory." Peterson provides a "process for integrating a maintenance supply network with an information

network for selectively distributing information about **inventory levels and pricing** among vendors.” Peterson, col. 1, ll.61-64 (emphasis added.) Peterson does not concern identifying a tagged vehicle in a first dealer’s inventory (for sale) as required by claims 1 and 17. Instead, Peterson provides a method of providing “vendors information about the **quantity** of the item each vendor has in inventory.” Peterson, col. 2, 1-2 (emphasis added.) No tagging of a specific item for sale is occurring.

Claims 31, 34-37, 39, 40, and 43-45, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al. (U.S. Patent No. 6,282,517 B1) in view Peterson et al. (U.S. Patent No. 6,324,522 B2) and further in view of Brockman (U.S. Patent No. 5,884,300).

Independent claims 31 and 45 are rejected for similar reasons regarding Wolfe and Peterson as set forth above for claims 1 and 17. The Examiner acknowledges that “Wolfe, Peterson, and Brockman do not teach that the second dealer is selected by the user.” For the same reasons as above, the Examiner’s inclusion of this limitation without a proper prior art reference is inappropriate.

The Examiner has inappropriately combined the Wolfe, Paterson, and Brockman references with a motivation or teaching to combine. The Applicant has set forth above the analysis for Wolfe and Paterson. Similarly, there is no motivation for combining Brockman with either Wolfe or Paterson. The Examiner attempts to provide the motivation for combining Wolfe and Paterson with the conclusory statement:

One of ordinary skill in the art would have been motivated to do so in order to eliminate the inefficiencies present in the supply chain and rapidly respond to market conditions and consumer demand, as taught by Brockman

Office Action dated May 5, 2004, p. 11-12

Again, the Examiner has looked in hindsight at the advantages of the present invention to provide the motivation to combine. Moreover, the Examiner has failed to point to any passage

in Wolfe, Peterson, or Brockman which can even implicitly be construed to suggest the combination of these references. The mere fact that one or more advantages may be gained by combining the references is not enough according to the M.P.E.P. and applicable case law.

Brockman **does not** provide the information asserted by the Examiner. The Examiner asserts that “[t]he cited prior art does not teach products in-transit and in-process products.” The Examiner uses Brockman to provide this limitation. To begin, the actual limitation that the Examiner is trying to establish is in claim 31:

generating a computerized search reply message in response to processing the search request message, the search reply message including a list of products matching at least one search criteria, including products in-inventory at the retailer identified by the retailer identifier as well as products in-transit to the retailer and in-process products

and in claim 45:

searching an inventory database for a product matching the product configuration data, the inventory database containing products on the order bank, in-production, in-transit, and in inventory

Brockman does not address searching and generating a search reply that includes in-transit and in-process products that will be presented to a potential buyer as in the present invention. Instead, Brockman is an inventory control system. The system of Brockman executes inventory management decisions “automatically from a comparison of model-determined inventory values and actual inventory values collected from the field.” (Brockman, col. 2, ll. 3-6). Brockman does not disclose a system where matching products are being searched for as in the present invention. Accordingly, Brockman does not provide the limitation of searching for matching in-transit and in-process products.

Applicants have demonstrated that independent claims 1, 17, 31 and 45 are allowable over the cited art. Accordingly, dependent claims 2-16, 18-22, 24-30, 32-44, and 46-50 are also allowable since each depends from an allowable independent claim.

### Conclusion

Applicants have made a genuine effort to respond to each of the Examiner's objections and rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is invited to contact the undersigned at his earliest convenience.

Applicants believe that no additional fees are required as a result of the filing of this paper. However, the Examiner is authorized to charge any additional fees or credits as a result of the filing of this paper to Ford Global Technologies, Inc.'s Deposit Account No. 06-1510 as authorized by the original transmittal letter in this case. If a telephone or video conference would help expedite allowance or resolve any additional questions, such a conference is invited at the Examiner's convenience.

Respectfully submitted,

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